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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,794	01/24/2002	Ellen Chapman	99-40112-US-C1	1543
7066 7590 01/25/2007 REED SMITH LLP 2500 ONE LIBERTY PLACE 1650 MARKET STREET PHILADELPHIA, PA 19103			EXAMINER TOMASZEWSKI, MICHAEL	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/057,794	Applicant(s) CHAPMAN ET AL.	
	Examiner Mike Tomaszewski	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice To Applicant***

1. This communication is in response to the amendment filed on 10/19/06. Claims 1-12 have been cancelled. Claims 13-35 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 13-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526; hereinafter Luchs), in view of Eisenmann (5,459,304; hereinafter Eisenmann).

(A) As per claim 13, Luchs discloses a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of

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insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

- (1) at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (2) a central computer (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (3) a database stored on the central computer in which data relating to at least one insurance policy is stored (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (4) software embodied in computer code configured to enable the at least one remote computer terminal to interact with the data stored in the database (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (5) a communicative connection connecting the at least one remote computer terminal with the central computer (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F);
- (6) wherein the software lists, for review by a user of the at least one remote computer terminal, a list of at least one expiring insurance policy corresponding to the data stored in the database (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; Fig. 1-11F); and
- (7) wherein the software enables the user of the at least one remote computer terminal to control, in response to the review of at least a portion of the at

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least one expiring insurance policy, the local printing of at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy, from the at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; col. 4, lines 48-59; col. 7, lines 5-27; col. 11, line 28-col. 12, line 41; Fig. 1-1F).

Luchs, however, fails to *expressly* disclose a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

- (8) wherein the software uses flags to flag a list of expiring insurance policies.

Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses a system for generating at least one of an insurance cancellation certificate, an insurance renewal certificate, or proof of insurance, from at least one remote computer terminal connected by a computer network to a central computer, the system comprising:

- (8) wherein the software uses flags to flag a list of expiring insurance policies (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(B) As per claim 14, Luchs discloses the system of claim 13, wherein the insurance cancellation certificate, the insurance renewal certificate, or the proof of insurance corresponds to insurance for a vehicle (Luchs: abstract; Fig. 1-11F).

(C) As per claim 15, Luchs discloses the system of claim 14, wherein the vehicle is an automobile (Luchs: abstract; col. 5, lines 10-12; Fig. 1-11F).

(D) As per claim 16, Luchs fails to *expressly* disclose the system of claim 14, wherein the vehicle is considered a "black car."

Examiner, however, respectfully submits that "black cars" (i.e., luxury passenger cars for hire) and other for-hire vehicles, such as, "silver cars," taxicabs, livery cars, limousines, and the like, are well known and obvious. Moreover, the practice of insuring these vehicles, just as insuring any other generic vehicle for that matter, and producing the requisite documents (e.g., insurance cancellation certificate, insurance renewal certificate, proof of insurance, etc.) to this end is well known and obvious.

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One of ordinary skill would have found it obvious at the time of the invention to combine this practice with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(E) As per claim 17, Luchs fails to *expressly* disclose the system of claim 13, wherein the insurance cancellation certificate is a standardized insurance termination certificate in accordance with an FH4 form.

Examiner, however, respectfully submits that FH4 forms and the technique of abiding the law by creating documentation that is in accordance with the law (e.g., creating standardized insurance documentation in accordance with a FH4 form, etc.) is well known and obvious.

One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(F) As per claim 18, Luchs fails to *expressly* disclose the system of claim 13, wherein the insurance renewal certificate is a standardized insurance renewal certificate in accordance with an FH1 form.

Examiner, however, respectfully submits that FH1 forms and the technique of abiding the law by creating documentation that is in accordance with the law (e.g., creating standardized insurance documentation in accordance with a FH1 form, etc.) is well known and obvious.

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One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(G) As per claim 19, Luchs fails to *expressly* disclose the system of claim 13, wherein the proof of insurance is a standardized proof of insurance certificate.

Examiner, however, respectfully submits that proof of insurance and the technique of developing standardized proof of insurance is well known and obvious.

One of ordinary skill would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of offering vehicular insurance (Luchs: abstract).

(H) As per claim 20, Luchs discloses the system of claim 13, wherein the at least one remote computer terminal comprises an interface, and wherein the interface displays the list for review by the user of the at least one remote computer terminal (Luchs: abstract; col. 2, line 56-col. 3, line 17; Fig. 1-11F).

Luchs, however, fails to *expressly* disclose a flagged list. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein the at least one remote computer terminal comprises an interface, and wherein the interface displays the flagged list (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).



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One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(I) As per claim 21, Luchs discloses the system of claim 13, wherein the list is generated automatically (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to *expressly* disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(J) As per claim 22, Luchs discloses the system of claim 13, wherein the list is generated automatically on a periodic basis (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to expressly disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13,

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wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

As per the limitation of "on a periodic basis," Examiner respectfully submits that the technique of performing acts (e.g., generating lists, etc.) at predefined time intervals (e.g., periodic basis, daily basis, etc.) is old and well known. One of ordinary skill in the art would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(K) As per claim 23, Luchs discloses the system of claim 13, wherein the list is generated automatically on a daily basis (Luchs: abstract; col. 3, lines 5-16; col. 5, lines 33-50; col. 29, lines 65-67; Fig. 1-11F).

Luchs, however, fails to *expressly* disclose the system of claim 13, wherein a flagged list is generated. Nevertheless, this feature is old and well known in the art, as evidenced by Eisenmann. In particular, Eisenmann discloses the system of claim 13, wherein a flagged list is generated (Eisenmann: abstract; col. 5, line 31-col. 6, line 33; Fig. 1-13D).

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One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Eisenmann with the teachings of Luchs with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

As per the limitation of "on a daily basis," Examiner respectfully submits that the technique of performing acts (e.g., generating lists, etc.) at predefined time intervals (e.g., periodic basis, daily basis, etc.) is old and well known. One of ordinary skill in the art would have found it obvious at the time of the invention to combine this technique with the combined teachings of Luchs and Eisenmann with the motivation of providing an efficient computerized insurance system (Luchs: col. 2, lines 21-26).

(L) As per claim 24, Luchs discloses the system of claim 13, wherein the software runs on the central computer (Luchs: abstract; col. 3, lines 5-17; Fig. 1-11F).

(M) Claims 25-35 substantially repeat the same limitations as those of claims 13-24 and are therefore, rejected for the same reasons given for those claims and incorporated herein.

### ***Response to Arguments***

4. Applicant's arguments filed 10/19/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/19/06.

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(A) On page 7 of the 10/19/06 response, Applicant argues that neither Luchs nor Eisenmann, alone or in combination, teaches or suggests a system wherein the software enables automatic local printing, in response to receiving a transmitted flagged list, of at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy, from the at least one remote computer terminal, as claimed in independent claims 13 and 25.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "automatic local printing") are not recited in the independent claims cited by Applicant (i.e., claims 13 and 25). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Nevertheless, Examiner respectfully submits that a broad, yet reasonable interpretation, of Luchs and Eisenmann does indeed teach Applicant's claimed invention, as recited in claims 13-35, including the feature of "automatic local printing." See §§ 3. (A) – (M), *supra*.

(B) On pages 7-8 of the 10/19/06 response, Applicant argues that Examiner, in the previous Office Action, asserted that Luchs does not teach or suggest a system for generating an insurance cancellation certificate, the insurance renewal certificate, or

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proof of insurance relating to one or more of the at least one expiring insurance policy from a remote computer terminal, where the software uses flags to flag a list of expiring insurance policies. As a result, Applicant argues that Luchs cannot teach or suggest software that controls or enables automatic local printing of the at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy in response to receiving the transmitted flagged list. Applicant further argues, with respect to Luchs, that the information must be reviewed and/or edited before issuing, in any format, a policy, and therefore, Luchs cannot enable or control printing of a policy based on any sort of information entered at the terminal, no less in response to receiving the transmitted flagged list, because such information must first be reviewed and/or edited before issuance.

In response, Examiner notes that Examiner did not consider the teachings of Luchs in a vacuum, rather Examiner considered the *combined teachings* of both Luchs and Eisenmann from the vantage point of a skilled artisan, that is, one of ordinary skill in the art.

In other words, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As such, Examiner respectfully submits that a broad, yet reasonable interpretation, of Luchs and Eisenmann, *in toto*, does indeed teach Applicant's claimed invention, as recited in claims 13-35. See §§ 3. (A) – (M), *supra*.

(C) On page 8 of the 10/19/06 response, Applicant argues that there is no teaching or suggestion of a system having software that controls or enables automatic local printing of the at least one of the insurance cancellation certificate, the insurance renewal certificate, or proof of insurance relating to one or more of the at least one expiring insurance policy in response to receiving the transmitted flagged list. Applicant argues further that there is no printing or issuance of any insurance relating to one or more of the at least one expiring insurance policy in the system, no less software that controls or enables local printing at a remote terminal any of these items in response to receiving the transmitted flagged list.

In response, Examiner notes that Examiner did not consider the teachings of Luchs in a vacuum, rather Examiner considered the *combined teachings* of both Luchs and Eisenmann from the vantage point of a skilled artisan, that is, one of ordinary skill in the art.

In other words, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As such, Examiner respectfully submits that a broad, yet reasonable interpretation, of Luchs and Eisenmann, *in toto*, does indeed teach Applicant's claimed invention, as recited in claims 13-35. See §§ 3. (A) – (M), *supra*.

(D) Applicant's remaining arguments in the response filed 10/19/02 rely on or re-hash the issues addressed above and therefore, are moot in view of the responses given above and incorporated herein.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



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